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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

**In re Application of:**

**Inventor:** Albert MODL et al

**Application No.:** 10/030,163

**Confirmation No:** 4360

**Filed:** April 25, 2002

**Atty. Docket No.:** MODL3002/JEK/JJC

**Customer No.:** 23364

**Examiner:** Daniel ST. CYR

**Art Unit:** 2876

**For:** METHOD, DEVICE AND SYSTEM FOR BIOMETRICALLY  
AUTHENTICATING A PERSON

**APPLICANTS' AMENDED APPEAL BRIEF**  
**IN ACCORDANCE WITH 37 C.F.R. § 41.37**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is an amended appeal brief filed pursuant to the applicants' appeal to the Board of Patent Appeals and Interferences from the rejection of claims 1-18 in the above-application. This amended appeal brief is in response to the Notice of Non-Compliant Appeal Brief mailed on April 4, 2005

An appeal brief was originally filed on July 19, 2004 before the effective date of September 13, 2004. Hence, any appeal brief in the pending application filed after the original appeal brief is governed under the old rules of 37 C.F.R. §§ 1.192 to 1.196, and not 37 C.F.R. § 41, as erroneously maintained in the Notice of Non-Compliant Appeal Brief. However, in order to expedite the review of this appeal brief on its merits, applicants have modified the original appeal brief filed on July 18, 2004 in accordance with the requirements in 37 C.F.R. § 41.37(c).

1. **REAL PARTY OF INTEREST**

The real party in interest is the assignee of record: Giesecke & Devrient GmbH  
(Munich, GERMANY).

2. **RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**3. STATUS OF CLAIMS**

**A. Status of Claims in Proceeding**

Claims 1-18 are currently pending in the above-referenced application.

Claims 1, 2, 4, 6-13 and 15 are rejected.

Claims 3, 5, 14 and 16-18 are objected to.

Claims 19-24 are not entered.

**B. Identification of Appealed Claims**

Applicants choose to appeal from the rejection of only independent claims 1, 10 and 13.

Claims 2-9 depend from claim 1 and their patentability is based on their dependency from claim 1 and their individually recited features. Claims 11 and 12 depend from claim 10 and their patentability is based on their dependency from claim 10 and their individually recited features. Claims 14-18 depend from claim 13 and their patentability is based on their dependency from claim 13 and their individually recited features.

The pending claims have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,719,950 ("Osten").

A copy of all of the pending claims and a listing of non-entered claims is included in the attached Appendix I. A copy of the Osten patent is included in the attached Appendix II, and a copy of the rejection dated February 23, 2004 is attached as Appendix III.

**4. STATUS OF AMENDMENTS**

An amendment of the pending claims in the present application was filed on July 19, 2004 which amended claims 8 and 9, canceled claims 3, 5, 14, and 16-18, and submitted new claims 19-24.

In the amendment, new claim 19 recited the subject matter of claims 1 and 2 combined with allowable subject matter of claim 3. New claim 20 recited the subject matter of claims 1 and 4 combined with allowable subject matter of claim 5. New claim 21 recited the subject matter of claim 13 combined with allowable subject matter of claim 14. New claims 22-24 recited the subject matter of claim 13 combined with allowable subject matter of claims 16-18, respectively.

The amendment of July 19, 2004 was acted upon by the Examiner and denied entry.

## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

At the onset of this section, it should be made known that the pending application was filed without drawings. Moreover, Applicants choose to appeal from the rejection of only independent claims 1, 10 and 13.

### **A. Claim 1**

Claim 1 is an independent claim that recites a method for biometric authentication of a person. The method includes the step of detecting biometric data of a person and storing the detected biometric data as reference data (page 2, lines 26-27). At least one parameter is determined that is based on at least one individual property of the person that specifically influences sensory detection of the biometric data (page 2, line 30 - page 3, line 3). The at least one parameter is stored and taken into account in at least one of the following method steps of: redetecting the person's biometric data (page 3, lines 4-6), comparing the redetected biometric data for a match with the reference data (page 3, lines 5-7), and authenticating the person if the match reaches a degree above a defined threshold value (page 3, line 7-9).

### **B. Claim 10**

Claim 10 is another independent claim that recites an apparatus comprising a first memory area with a person's biometric data as reference data (page 2, lines 26-28), and a second memory area with a parameter based on at least one individual property of the person that specifically influences the sensory detection of the biometric data (page 2, lines 30-32).

### **C. Claim 13**

Claim 13 is yet another independent claim that recites a system including a first memory area with a person's biometric data serving as reference data (page 2, lines 26-28), and a second memory area with a parameter based on at least one individual property of the person that specifically influences the sensory detection of the biometric data (page 2, lines 30-32). The system further includes a first device for detecting a person's biometric data (page 3, lines 19-25), and a second device for comparing the reference data stored in the first memory area of the apparatus for a match with the person's detected biometric data (page 1, lines 5-7; page 1, lines 12-14). The second device authenticates the person if the match reaches a degree above a defined threshold value (page 3, lines 11-17). At least one of the

first and second devices is coupled with the parameter stored in the second memory area of the apparatus (page 3, lines 7-9).

D. Claims 2-9, 11, 12 and 14-18

Since claims 2-9, 11, 12 and 14-18 rise or fall based on their dependency from one of claims 1, 10 and 13, a summary for each of these dependent claims is not considered necessary.

**6. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1 to 18 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,719,950 (Osten).



## 7. ARGUMENT

### A. The Rejection

Claims 1, 10 and 13 in this application were finally rejected under 35 U.S.C. § 102(b) as being anticipated by the Osten patent.

### B. Pertinent Law

To establish anticipation under 35 U.S.C. § 102(b), “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Vergegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). There is no anticipation “unless all of the same elements are found in exactly the same situation and united in the same way ... in a single prior art reference.” *Perkin-Elmer Corp. v. Computervision Corp.*, 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984) (citing *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983). Absence from the reference of any claimed element negates anticipation. *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed.Cir.1986).

### C. The Osten Patent Fails To Disclose Or Suggest A Method, Apparatus Or System Utilizing A Parameter That Specifically Influences Sensory Detection Of Biometric Data

The Osten patent generally relates to a system that employs specific biometric data and at least one “non-specific” biometric parameter in separate and unrelated tests to authenticate an individual person (col. 3, lines 28-53).

Significantly, the teachings of the Osten patent fail to disclose or suggest establishing or using a “parameter” that “specifically” influences the sensory detection of the biometric data used to authenticate the individual. Indeed, while the specific biometric data is unique to the individual person being authenticated, the non-specific biometric parameters are merely used to determine if the obtained information relates to “acceptable norms” (col. 3, lines 56-59; col. 4, lines 14-22), and whether the individual is not “incapacitated, dismembered, or deceased” (col. 6, lines 9-13).

Contrary to the methods and embodiments recited in claims 1, 10 and 13 of the present application, there is simply no disclosure of a secondary test that specifically confirms the validity of the specific biometric data in the Osten patent. According to the Osten patent, the physiological norms of the non-specific biometric parameters include characteristics such as bone structure, physical dimensions, skin temperature, electrocardiographic signals, pulse and spectral characteristics of human tissue (col. 3, lines 1-13, lines 61-67). These non-specific biometric parameters are clearly described as being “not unique” to the individual (col. 2, lines 66-67). This non-specific information is only used to determine if the obtained data falls within acceptable norms (col. 3, lines 56-59; col. 4, lines 14-22).

Unlike the teachings of the Osten patent, claims 1, 10 and 13 recite that the at least one individual property upon which the “parameter” is based directly relates to an individual property of the person. It follows that this parameter is not a random value indistinguishable from person to person, as is the non-specific biometric parameter in the Osten patent. Instead, in the method and embodiments of the present application, the parameter is in reference to the person’s “individual” properties and is therefore “unique” to the person (page 2, first paragraph in the specification of the present application).

Since the Osten patent fails to disclose or suggest using a “parameter” based on a person’s individual properties that specifically influences the sensory detection of specific biometric data of related to the person, the Osten patent cannot possibly be construed to disclose or suggest the pertinent limitations of claims 1, 10 and 13 of the present application.

Keeping in mind the basis of the “parameters” in the claims of the present application, it will be pointed out that the individual parameters are stored and subsequently used to redetect biometric data, compare the redetected biometric data for a match with reference data or authenticate a person if the match reaches a degree above a defined threshold value. In view of the Osten patent, there is clearly no disclosure or suggestion in the teachings in the Osten patent of storing at least one parameter that specifically influences specific biometric data based on an individual property of the person being tested that will be taken into account in a subsequent process in confirming the authenticity of such specific biometric data. This assertion is further supported by the fact, as discussed above, that the non-specific biometric parameters in the Osten patent are not related to any particular individual.

As clearly illustrated in FIG. 7 of the Osten patent, the authentication processes involving specific biometric information and non-specific biometric information are parallel processes that are conducted separately and concurrently (col. 10, lines 12-15). Neither process depends upon the other, and the authentication process may be terminated if only one of the processes yields an unacceptable comparison (col. 10, lines 38-49). Authentication is performed only when both processes are complete and there are acceptable comparisons between the measured information and stored information.

In a contradistinction, the process of authenticating a person in accordance with the method of claim 1, the apparatus of claim 10, and the system of claim 13 of the present application do not rely on two separate authentication processes. Instead, the at least one parameter is dependent or specifically related to biometric data, and modification or adjustment due to the at least one parameter is taken into account in determining the authenticity of such biometric data.

It is simply illogical to construe non-specific biometric information as the equivalent of at least one parameter based on an individual property of a person that specifically influences sensory detection of specific biometric data.

When properly interpreted, the Osten patent requires two separate and parallel recognition and comparison subsystem processes using specific and non-specific biometric information. The Osten patent does not discuss or show such a parameter that "specifically" influences the sensory detection of the biometric data, but instead describes parallel recognition and comparison subsystems used for specific biometric recognition and non-specific biometric recognition. Although the Osten patent does describe authenticating a person using biometric information, it does not disclose or suggest using at least one parameter based on at least one individual property that specifically influences sensory detection of such biometric data. Thus, even an artisan of ordinary skill must guess about how exactly in a separate yet parallel subsystem a determination of non-specific biometric information would substitute for the at least one parameter based on at least one individual property recited in the claims of the present application.

If the claims of the present application were properly interpreted, it is readily apparent that the separate subsystem for authenticating the specific biometric data in the Osten patent would require determining at least one parameter in order to anticipate the claims of the

present application. About the most that can be said for the Osten patent is that the subsystem for authenticating the specific biometric data is not explicitly described as being inconsistent with the method, apparatus and system of the present application. However, this negative pregnant is not enough to show anticipation. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1997) (in order to anticipate, "the [prior art] reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it").

It is therefore submitted that the Osten patent does not disclose or suggest each and every element recited in claims 1, 10 and 13 of the present application. Moreover, the Osten patent fails to describe elements that are found in exactly the same situation and united in the same way as recited in the methods and embodiments of the present application. Accordingly, claims 1, 10 and 13 are not anticipated by the teachings of the Osten patent.

8. **CONCLUSION**

For the reasons set forth above, independent claims 1, 10 and 13 of the pending application define subject matter which is not anticipated within the meaning of 35 U.S.C. § 102(b) by the Osten patent.

The Office is authorized to charge any additional fees associated with this communication to Deposit Account No. 02-0200.

In accordance with 37 C.F.R. § 41, only one copy of this amended brief is filed.

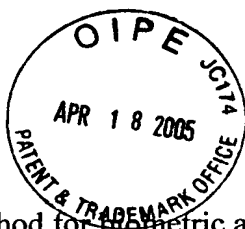
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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. Cassell", written in a cursive style.

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1 . A method for biometric authentication of a person, comprising the steps of detecting biometric data of a person and storing the detected biometric data as reference data,

determining at least one parameter based on at least one individual property of the person that specifically influences sensory detection of said biometric data, and storing the determined parameter to be taken into account in at least one of the following method steps,

redetecting the person's biometric data,

comparing the redetected biometric data for a match with the reference data, and

authenticating the person if the match reaches a degree above a defined threshold value.

2. The method according to claim 1, characterized in that the determined parameter is taken into account in the step of authenticating the person.

3. The method according to claim 2, characterized in that the defined threshold value is dependent on the determined parameter.

4. The method according to claim 1, characterized in that the determined parameter is taken into account in the step of redetecting the biometric data.

5. The method according to claim 4, characterized in that the determined parameter is used for adjusting a sensor system for redetecting the biometric data.

6. The method according to claim 1, characterized in that the person is granted limited possibilities of activity depending on the determined parameter.

7. The method according to claim 1, characterized in that the person is granted limited possibilities of activity depending on the degree of the match between the redetected biometric data and the stored reference data.

8. The method according to claim 1, characterized by the additional step of adapting a sensor system for redetecting the biometric data to the environmental conditions prevailing at the time of redetection.

9. The method according to claim 7, characterized in that the environmental conditions prevailing during detection of the biometric data as reference data are stored and taken into account when the sensor system is adapted upon redetection of the biometric data to the environmental conditions prevailing at the time of redetection.

10. An apparatus comprising a first memory area with a person's biometric data as reference data and a second memory area with a parameter based on at least one individual property of the person that specifically influences the sensory detection of said biometric data.

11. The apparatus according to claim 10, characterized in that the apparatus is a data carrier, in particular a smart card.

12. The apparatus according to claim 10, comprising a third memory area with information on the environmental conditions prevailing during detection of the biometric data contained in the first memory area.

13. A system comprising  
an apparatus having a first memory area with a person's biometric data as reference data and a second memory area with a parameter based on at least one individual property of the person that specifically influences the sensory detection of said biometric data,  
a first device for detecting a person's biometric data, and  
a second device for comparing the reference data stored in the first memory area of the apparatus for a match with the person's detected biometric data and authenticating the person if the match reaches a degree above a defined threshold value, at least one of the devices being coupled with the parameter stored in the second memory area of the apparatus.

14. The system according to claim 13, characterized in that the second memory area of the apparatus with the determined parameter and the device for authenticating the person are coupled by the defined threshold value depending on the determined parameter.

15. The system according to claim 13, characterized in that the second memory area with the determined parameter and the device for detecting the person's biometric data are coupled by the determined parameter being taken into account during adjustment of a sensor system for detecting the biometric data.

16. The system according to claim 13, characterized in that the system contains an activity filter which is variable in dependence on the determined parameter.



17. The system according to claim 13, characterized in that the system contains an activity filter which is variable in dependence on the degree of the match between the redetected biometric data and the stored reference data.

18. The system according to claim 13, characterized in that the device for detecting the person's biometric data includes a sensor system which is variably adjustable to the environmental conditions prevailing during detection of the person's biometric data depending on the information stored in the third memory area of the apparatus.

Claims 19-24 (Not Entered)